

# Notice of Allowability

## Application No.

09/103,846

## Examiner

Joseph T. Woitach

## Applicant(s)

WOYCHIK ET AL.

## Art Unit

1632

### -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to December 18 1993.
2. ☒ The allowed claim(s) is/are 51-57.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date page 3-May 27, 1999
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2003 has been entered.

**DETAILED ACTION**

This is an original application filed June 24, 1998.

Applicants' amendment filed December 18, 2003 has been received and entered. The specification has been amended. Claims 1-50 have been canceled. Claim 51 has been amended. Claims 51-57 are pending and currently under examination.

***Information Disclosure Statement***

During review of the application it was noted that the third page of the IDS filed May 27, 1999 was not signed, though it appeared that it was considered by the previous Examiner. For the sake of completeness a signed copy of the third page is included with this action.

***Claim Objections***

Claim 51 objected to because it contains editor marks with recitations of embodiments which are also presented previously in the claim (70% limitation) is withdrawn.

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The amendment to the claim has obviated the basis of the rejection.

### ***Specification***

The disclosure objected to because the specification contains several references to an active executable code is withdrawn.

The amendment to the specification has obviated the basis of the objection.

### ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance:

As indicated previously, claims 51-57 are free of the art of record because the art fails to teach that as little as 200-600 ES cells could successfully be used in the recited methods. The amendment to claim 51 has addressed the basis of the rejection set forth under 35 USC 112, second paragraph, obviating the remaining rejection of record.

The closest teaching to this low range of cells as a starting material is by Schafer *et al.* who suggest that as few as 1000 organisms (i.e cells) could be used to obtain a single mutant copy of a gene (column 6; lines 45-54). In addition, Schafer *et al.* do teach as little as 300 mice can be used (Example 1: column 14; lines 58-67), however in this example the spermatogonia are the target cells, and thus, represent many more cells as starting material than 300 cells, and therefore would be outside the range of 200-600 cells.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571) 272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach

APPROPRIATE  
TO BE FORWARDED  
Joe Woitach  
AU1632